

REMARKS

Claims 1-3, 6-8, 12, 15, 16, 19, and 20 are pending in the application. No claim is being amended at this time. The foregoing listing of claims is provided for the convenience of the Office.

It is Applicants' understanding from the Office Action that the obviousness-type double patenting rejections listed below have been maintained.

[A] Listing of the Rejections

[1] Claims 1-3, 6-8, 12, 15, 16, 19, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-6, 13-18, 22, and 24 of USSN 12/167,513 (Office Action, page 6).

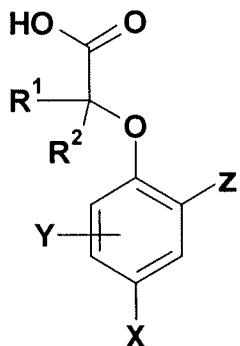
[2] Claims 1-8 and 10-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 26-32 of USSN USSN 12/089,276 (Office Action, page 7).

[3] Claims 1-8 and 10-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-11 of USSN USSN 11/576,372 (Office Action, page 7).

[4] Claims 1-8 and 10-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-4, 6-8, 12, 13, 14, and 16-19 of USSN 10/552,082 (Office Action, page 7).

[B] Rejection based on USSN 10/552,082

Claim 1 in USSN 10/552,082 is directed to compounds having the following formula:



On July 2, 2010, Applicants filed an Amendment in Reply to a non-final Office Action that was issued in connection with USSN 10/552,082. A copy of the Reply is enclosed herewith. As can be seen, claim 1 in USSN 10/552,082 presently requires that variable Y must be hydrogen; and variable X must be C₁₋₆alkyl or OR⁶, in which R⁶ is a hydrogen atom or C_{1-C₆}alkyl.

The present claims also require that Y must be hydrogen; however, in contrast to USSN 10/552,082, the present claims require that variable X must be halogen, cyano, nitro, S(O)_nR⁶ (wherein n is 0, 1 or 2) or C₁₋₄alkyl which is substituted by one or more halogen atoms.

As such, the present application and USSN 10/552,082 do not overlap, and Applicants respectfully request that the rejection be reconsidered and withdrawn for at least this reason.

[C] Rejections based on USSN 12/167,513, USSN 12/089,276, and USSN 11/576,372

[1] The present application is the U.S. National Stage under 35 U.S.C. § 371 of PCT International Application No. PCT/SE2004/000535, filed April 6, 2004.

[2]

USSN 12/167,513 was filed on July 3, 2008 and claims the benefit of U.S. Provisional Application No. 60/948,012, filed on July 5, 2007.

USSN 12/089,276 is the U.S. National Stage under 35 U.S.C. § 371 of PCT International Application No. PCT/GB2006/003697, filed October 5, 2006.

USSN 11/576,372 is the U.S. National Stage of PCT International Application No. PCT/GB2005/003794, filed October 3, 2005.

[3] As can be seen, the present application was filed earlier than any of USSN 12/167,513; USSN 12/089,276; and USSN 11/576,372.

[4] If an earlier filed application has claims that are conflicting with those in a later filed application, and a provisional double patenting rejection is the only rejection remaining in the earlier filed application, then the Office should withdraw the double patenting rejection in the earlier filed application and allow it to issue without a terminal disclaimer. See MPEP § 822.01 and 804 (emphasis added):

Where claims in one application are unpatentable over claims of another application of the same inventive entity (or different inventive entity with common ownership) because they contain conflicting claims, a complete examination should be made of the claims of each application and all appropriate rejections should be entered in each application, including rejections based upon prior art. The claims of each application may also be rejected on the grounds of "provisional" double patenting on the claims of the other application whether or not any claims avoid the prior art. ...

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications. ...

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

[5] In view of the amendments to USSN 10/552,082 (see discussion in section [B] above), it is submitted that the above-discussed three provisional double patenting rejections will stand as the only rejections remaining in the present application. Since the present application

Applicant : Bonnert et al.
Serial No. : 10/551,783
Filed : July 7, 2006
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was filed earlier than any of USSN 12/167,513; USSN 12/089,276; and USSN 11/576,372, it is respectfully requested that the Office withdraw these three provisional double patenting rejections and permit the present application to issue without the filing of a terminal disclaimer.

No fee is believed due. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 06275-0474US1/101016-1P US.

Respectfully submitted,

Date: July 23, 2010

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Pairaudeau et al.
Serial No. : 10/552,082
Filed : October 5, 2005
Title : NOVEL COMPOUNDS

Art Unit : 1626
Examiner : Shawquia Young
Conf. No. : 8802

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT IN REPLY TO ACTION OF JANUARY 7, 2010

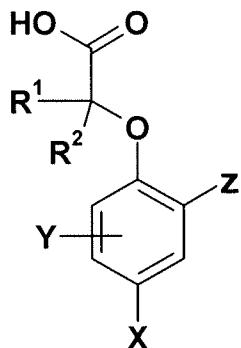
Please amend the above-identified application as follows:

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in the application:

Listing of Claims:

1. (Currently Amended) A compound of formula (I) or a pharmaceutically acceptable salt thereof:



(I)

in which:

X is C₁₋₆alkyl or OR⁶;

Y is selected from hydrogen, halogen, CN, nitro, SO₂R³, OR⁴, SR⁴, SOR³, SO₂NR⁴R⁵, CONR⁴R⁵, NR⁴R⁵, NR⁶SO₂R³, NR⁶CO₂R⁶, NR⁶COR³, C₂-C₆-alkenyl, C₂-C₆-alkynyl, C₃-C₇-cycloalkyl or C₁₋₆alkyl, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, OR⁶ and NR⁶R⁷, S(O)_nR⁶; n is 0, 1 or 2;

Z is phenyl optionally substituted by one or more substituents independently selected from hydrogen, halogen, CN, OH, SH, nitro, COR⁹, CO₂R⁶, SO₂R⁹, OR⁹, SR⁹, SOR⁹, SO₂NR¹⁰R¹¹, CONR¹⁰R¹¹, NR¹⁰R¹¹, NHSO₂R⁹, NR⁹SO₂R⁹, NR⁶CO₂R⁶, NHCOR⁹, NR⁹COR⁹, NR⁶CONR⁴R⁵, NR⁶SO₂NR⁴R⁵, aryl,

C₂-C₆ alkenyl, C₂-C₆ alkynyl, C₃-C₇ cycloalkyl or C₁₋₆alkyl, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, OR⁶, NR⁶R⁷, S(O)_nR⁶, CONR⁶R⁷, NR⁶COR⁷, SO₂NR⁶R⁷ and NR⁶SO₂R⁷.

R¹ and R² independently represent a hydrogen atom, halogen, C₂-C₆ alkenyl, C₂-C₆ alkynyl, C₃-C₇ cycloalkyl or a C₁₋₆alkyl group, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, NR⁶R⁷, OR⁶, S(O)_nR⁶;

R³ represents C₃-C₇ cycloalkyl or C₁₋₆alkyl which may be optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, OR⁶ and NR⁶R⁷, S(O)_nR⁶, CONR⁶R⁷, NR⁶COR⁷, SO₂NR⁶R⁷ and NR⁶SO₂R⁷;

R⁴ and R⁵ independently represent hydrogen, C₃-C₇ cycloalkyl or C₁₋₆alkyl, the latter two groups being optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, OR⁶ and NR⁶R⁷, S(O)_nR⁶, CONR⁶R⁷, NR⁶COR⁷, SO₂NR⁶R⁷ and NR⁶SO₂R⁷;

R⁶ and R⁷ independently represents a hydrogen atom or C₁-C₆ alkyl;

R⁸ is hydrogen, C₁₋₄ alkyl, -COC₁-C₄ alkyl, CO₂C₁-C₄alkyl or CONR⁶C₁-C₄alkyl;

R⁹ represents aryl, C₃-C₇ cycloalkyl or C₁₋₆alkyl, the latter two groups may be optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, aryl, OR⁶ and NR⁶R⁷, S(O)_nR⁶, CONR⁶R⁷, NR⁶COR⁷, SO₂NR⁶R⁷ and NR⁶SO₂R⁷;

R^{10} and R^{11} independently represent aryl, hydrogen, C₃-C₇ cycloalkyl or C₁₋₆alkyl, the latter two groups being optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, aryl, OR⁶ and NR⁶R⁷, S(O)_nR⁶, CONR⁶R⁷, NR⁶COR⁷, SO₂NR⁶R⁷ and NR⁶SO₂R⁷.

2. (Previously Presented) A compound according to claim 1 in which R¹ and R² independently represent a hydrogen atom, C₂-C₆ alkenyl, C₂-C₆ alkynyl, C₃-C₇ cycloalkyl or a C₁₋₆alkyl group, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, C₃-C₇ cycloalkyl, NR⁶R⁷, OR⁶, S(O)_nR⁶.
3. (Previously presented) A compound according to claim 1 in which X is C₁₋₄alkyl or C₁-alkoxy.
4. (Cancelled)
5. (Cancelled)
6. (Previously Presented) A compound according to claim 1 in which Z is substituted by one or more substituents independently selected from halogen, C₁₋₃alkyl, cyano and SO₂R⁹.
7. (Previously presented) A compound according to claim 1 in which R¹ and R² are both hydrogen or one is hydrogen and the other is C₁₋₃ alkyl.
8. (Currently Amended) A compound according to claim 1 selected from:
[(5-Methylbiphenyl-2-yl)oxy]acetic acid,
{[5-Ethyl-4'-(methylsulfonyl)biphenyl-2-yl]oxy}acetic acid,
{[4'-(Ethylsulfonyl)-5-methoxybiphenyl-2-yl]oxy}acetic acid,

~~[[4-Chloro-4'-(ethylsulfonyl)-2',5-dimethyl[1,1'-biphenyl]-2-yl]oxy] acetic acid,~~
[[4'-(Ethylsulfonyl)-2',5-dimethyl[1,1'-biphenyl]-2-yl]oxy]-acetic acid,
2-[[3'-Cyano-5-methyl[1,1'-biphenyl]-2-yl]oxy]-(2S)-propanoic acid,
2-[[2'-Fluoro-5'-cyano-5-methyl[1,1'-biphenyl]-2-yl]oxy]-(2S)-propanoic acid,
and pharmaceutically acceptable salts thereof.

Claims 9-11 (Cancelled)

12. (Previously presented) A method for the therapeutic treatment of asthma or rhinitis in a patient suffering from asthma or rhinitis, which comprises administering to the a patient suffering from asthma or rhinitis a therapeutically effective amount of a compound of formula (I), or a pharmaceutically acceptable salt as defined in claim 1.

13. (Previously presented) A compound according to claim 2 in which X is C₁₋₄alkyl or C₁₋₄alkoxy.

14. (Cancelled)

15. (Cancelled)

16. (Previously presented) A compound according to claim 2 in which Z substituted by one or more substituents independently selected from halogen, C₁₋₃alkyl, cyano and SO₂R⁹.

17. (Previously presented) A compound according to claim 2 in which R¹ and R² are both hydrogen or one is hydrogen and the other is C₁₋₃ alkyl.

18. (Previously presented) A pharmaceutical composition comprising a compound of formula (I) as claimed in claim 1, or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable adjuvant, diluent, or carrier.

19. (Previously presented) A method of producing a CRTh2 receptor inhibitory effect in a patient, which comprises administering to the patient an effective amount of a compound of formula (I) as claimed in claim 1 or a pharmaceutically acceptable salt thereof.

REMARKS

Claims 1-4, 6-8, 12-14, and 16-19 are pending.

Applicants have amended claim 1 to incorporate the subject matter of claim 4 and cancelled claims 4 and 14 without prejudice. Applicants have amended claim 8 to comport in scope with claim 1 in its presently amended form. Claims 1-3, 6-8, 12, 13, and 16-19 will therefore be pending upon entry of the proposed amendments.

The foregoing amendments, which introduce no new matter, are being made for the sole purpose of expediting prosecution of the present application; and Applicants expressly reserve the right to pursue any cancelled subject matter in one or more continuing applications.

Claims 1-3, 6-8, 12, 13, and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-8 and 10-20 of “copending US application 10/551,783” (Office Action, page 3).

Applicants respectfully disagree with the grounds for the rejection; however, for the sole purpose of expediting prosecution of the present application, Applicants have amended claim 1 to incorporate the subject matter of claim 4, a dependent claim that was not rejected on the ground of nonstatutory obviousness-type double patenting over US application 10/551,783.

In view of the foregoing, Applicants respectfully request that the rejection be reconsidered and withdrawn.

Applicant : Pairaudeau et al.
Serial No. : 10/552,082
Filed : October 5, 2005
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Attorney's Docket No.: 06275-0472US1 / 101017-1P
US/R&I

The fee in the amount of \$1,110 for the Three Month Extension of Time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 06275-0472US1 / 101017-1P US.

Respectfully submitted,

Date: July 2, 2010

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